

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed March 17, 2009. At the time of the Final Office Action, Claims 13, 15-20 and 22-25 were pending in this Application. Claims 1-12, 14 and 21 were previously cancelled without prejudice or disclaimer. Claims 13, 15-20 and 22-25 were rejected. Claims 16, 18 and 23 are hereby amended and new claim 26 is hereby added. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 13-14 and 20-21 stand rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,941,146 issued to Robert Knauerhase et al. (“Knauerhase”). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Claim 13 recites, “a fourth item of network information *uniquely* identifying the local area network, and *establishing and permitting a connection* to a local wireless network to receive the third party service *based on the stored access information.*” (emphasis added). Claim 20 recites similar limitations. According to the specification, a problem exists with prior systems in that there is a requirement to have a WLAN module with the appropriate technology for the respective WLAN access.

[0007] Because of the application of WLAN in hot spots it is assumed that in the future there will be a plurality of public as well as private WLAN providers worldwide, with each also operating their respective networks with different WLAN technologies. *A problem for UMTS terminals using WLAN*

is the requirement to have a WLAN module with the appropriate technology for the respective WLAN access. An additional problem is that the respective UMTS terminal must also register as a customer with the respective network provider, either on the basis of a contract or dynamically at the present location.

(Specification at [0007]) (emphasis added). To help solve this problem, embodiments of the present invention *uniquely* identify the local area network. When the local area network is uniquely identifiable, dedicated selection of networks and restricted access may be possible.

[0016] Whereas information relating to location, type and services provided is adequate, primarily for the identification of and access to public local area networks, *a fourth item of information by means of which the local area network is uniquely identifiable, said information being included as part of the second item of identification information, permits the dedicated selection of networks, which selection is necessary in particular when a restriction of the access to the respective local area networks has been imposed either on the part of the provider of the mobile radio system or on the part of operators of local area networks.*

(Specification at [0016]) (emphasis added). *Uniquely* identification of local area networks offers several benefits.

[0079] Accordingly, a method may be implemented under the embodiment for encoding WLAN identities for the identification and authentication of WLAN networks as well as the WLAN access of UMTS users on the basis of WLAN identity lists that are stored on the USIM. It is assumed as a precondition here that the UMTS terminal also has a WLAN module of the respective technology. A USIM-based solution offers the following advantages:

- WLAN networks can be identified and authenticated in an certain manner.
- Access by UMTS subscribers in WLAN networks is realized in an uncomplicated manner.
- UMTS and WLAN providers can control the WLAN access for specific networks or, as the case may be, classes of networks.

(Specification at [0079]-[0082]). The specification clearly explains embodiments for *uniquely* identifying the local area network.

[0083] To enable the identification and authentication of WLAN networks, the networks are encoded under the embodiment by means of an identity which is composed of the following four components:

- **WLAN identity = MCC + WTC + WAC + WNC**, where

- the **Mobile Country Code (MCC)** comprises three digits (decimal) and uniquely identifies the country in which the WLAN network is operated,
- the **WLAN Type Code (WTC)** comprises a maximum of three digits (decimal) and uniquely identifies the type of the WLAN network,
- the **WLAN Application Code (WAC)** comprises a maximum of three digits (decimal) and uniquely identifies the WLAN application,
- the **WLAN Network Code (WNC)** comprises a maximum of five digits (decimal) and uniquely identifies the WLAN network on the basis of the MCC, WTC and WAC.

(Specification at [0083]-[0088]). The specification further explains different codes that may be used for *uniquely* identifying the local area network by specifying a WLAN either public or private as well as specifying a type of facility such as airport, hotel, etc.

[0089] The length of a WLAN identity comprises a maximum of fourteen digits (decimal). Other combinations are possible for the definition of WTC and WAC. For example, the following could be defined as WLAN Type Codes:

- "001" = Public, Type 1
- "002" = Public, Type 2
- "003" = Private, Type 1
- "004" = Private, Type 2
- etc.

[0095] Similarly, the following could be defined as WLAN Application Codes:

- "001" = Airport
- "002" = Hotel, Luxury Category
- "003" = Hotel, Midrange Category
- "004" = Station
- "005" = Coffee Shop
- etc.

(Specification at [0089]-[00101]). Lists may also be used to *uniquely* identify the local area network so that subscribers may be permitted access.

[0102] Alternatively, the WLAN access is determined on the basis of WLAN identity lists. For this purpose the files EF_AWPLMN (Allowed WLAN PLMNs) and EF_FWPLMN (Forbidden WLAN PLMNs) are defined on the USIM. The file EF_AWPLMN contains in the form of a list the identities of the WLAN networks permitted for a UMTS subscriber and has a length of n*7

bytes as standard. Similarly, the file EF_FWPLMN contains in the form of a list the identities of the WLAN networks prohibited for a UMTS subscriber and has a length of $n*7$ bytes as standard. The parameter n specifies the number of WLAN networks contained in the list. Seven bytes are allocated for the identity per listed WLAN network. The seven bytes result from the fact that each individual digit of the WLAN identity is coded using four bits in each case. Table 1 shows an example of the structure of the file EF_AWPLMN or, as the case may be, EF_FWPLMN.

[0103] TABLE 1 Structure of the file EF_AWPLMN or EF_FWPLMN

Bytes	Description	Length
1 to 7	1st WLAN PLMN	7 bytes
8 to 14	2nd WLAN PLMN	7 bytes
...
(7*n - 6) to (7*n)	Nth WLAN PLMN	7 bytes

[0104] These WLAN identity lists enable a UMTS user, upon signing a contract with his/her UMTS or WLAN provider, to be allowed or barred from corresponding WLAN accesses depending on whether he/she wishes also to use WLAN in addition to UMTS. The WLAN identity lists further permit the dynamic handling of the allowed or, as the case may be, barred WLANs also during the term of the contract.

(Specification at [0102]-[00104]). By way of example, the specification explains that *uniquely* identified local area networks allows subscribers to set up internet connections with his/her UMTS terminals by way of his/her WLAN modules.

[0105] For the purpose of explaining the application of the approach according to the invention it is assumed that a mobile radio subscriber in Germany is currently at an airport and wants to set up an internet connection with his/her UMTS terminal by way of a WLAN radio network based on the IEEE 802.11b technology. His/her terminal possesses a corresponding WLAN module, and on his/her USIM, in the file EF_AWPLMN, as depicted in FIG. 4, there are stored the allowed WLAN networks, and in the file EF_FWPLMN, as depicted in FIG. 5, there are stored the barred WLAN networks.

[0106] On his/her USIM, the file EF_AWPLMN contains four entries. According to entry 1, he/she is allowed a WLAN access in Germany in any WLAN network of the type "Public, Type 1" and application "Airport". According to entry 2, the same also applies to all WLAN networks of the type "Private, Type 1" and application "Hotel, Luxury Category". According to entry 3, he/she also has a WLAN access in the United Kingdom in any WLAN network of the type "Public, Type 1" and application "Airport". Finally,

according to entry 4, he/she has worldwide access to all WLAN networks of the type "Private, Type 1" and application "Coffee Shops".

[0107] On his/her USIM, the file EF_FWPLMN contains two entries. According to entry 1, in Germany the user is not allowed a WLAN access in any WLAN network of the type "Public, Type 2", regardless of the application. According to entry 2, the user is not allowed access to a specific WLAN network in the United Kingdom having WNC=017, Type "Public, Type 2" and application "Hotel, Luxury Category".

[0108] According to entry 1 in EF_AWPLMN, a WLAN access in Germany from an airport is allowed, so the mobile radio subscriber can set up an internet connection with his/her UMTS terminal by way of his/her WLAN module.

(Specification at [0105]-[00108]).

A premise of the rejection is that Knauerhase teaches "establishing a connection to a local wireless network to receive the third party service based on the stored access information (FIG. 6, col. 4 lines 58-59 and col. 5 lines 10-33)." (FOA at 7). However, nowhere in the rejection is it argued that Knauerhase teaches "*establishing and permitting a connection* to a local wireless network to receive the third party service *based on the stored access information*" as claimed. It appears that the examiner has recognized this difference where it is stated that "Examiner is persuaded that the cited portion does not clearly disclose the limitation," because "Knauerhase addresses distributing network information, and not authorization of network connections." (See FOA at 3). The failure of Knauerhase to teach *permitting a connection* is underscored by its failure to teach *unique* identification of local area networks. A further premise of the rejection is that col. 3, lines 24-26 and lines 32-27 of Knauerhase disclose uniquely identified local area networks. (FOA at 2). However, this disclosure merely teaches that the mobile device may detect whether service is being provided to the place where the device is located, in other words, the mobile device can detect whether it is getting a signal for particular transceivers. This premise of the rejection fails because this disclosure of Knauerhase does nothing to teach or suggest "*permitting a connection . . . based on the stored access information*," which includes "a fourth item of network information *uniquely* identifying the local area network." Therefore, the invention

as claimed in claims 13 and 20 is patentable in view of *Knauerhase*. The inventions as claimed in the dependent claims are patentable for similar reasons.

Rejections under 35 U.S.C. §103

Claims 15-16 and 22-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Knauerhase*.

Claims 17-19 and 24-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Knauerhase* in view of U.S. Patent Application Publication No. 2003/0119481 by Henry Haverinen et al. (“*Haverinen*”).

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Claim 13 recites, “a fourth item of network information *uniquely* identifying the local area network, and *establishing and permitting a connection* to a local wireless network to

receive the third party service *based on the stored access information.*” (emphasis added). Claim 20 recites similar limitations. As noted above, the invention as claimed in claims 13 and 20 is patentable in view of Knauerhase because it fails to teach or suggest these limitations. Haverinen et al also fails to teach or suggest these limitations. Claims 17-19 and 24-25 depend from claims 13 and 20. The inventions as claimed in these dependent claims are patentable for similar reasons as described above for claims 13 and 20.

Request for Continued Examination

Applicants respectfully submit a Request for Continued Examination (RCE) Transmittal. The Commissioner is authorized to charge any fees required to Deposit Account 50-4871 in order to effectuate these filings.

Association of Customer Number and Change of Correspondence Address

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer No. **86528**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **86528**. All telephone calls should be directed to counsel at 512.457.2026. A Revocation and Power of Attorney will be filed shortly.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully requests reconsideration of the pending claims.

Applicants submit a Request for Continued Examination. The Commissioner is authorized to charge the fee of \$810.00 required to Deposit Account 50-4871 of King & Spalding LLP in order to effectuate this filing.

Applicants believe there are no additional fees due at this time. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding LLP.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457.2026.

Respectfully submitted,
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